



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/807,120 02/19/97 LEYDEN

R 831.00029

EXAMINER

WM02/0313

WOOD PHILLIPS VAN SANTEN CLARK AND
MORTIMER
500 WEST MADISON STREET
SUITE 3800
CHICAGO IL 60661

ART UNIT

PAPER NUMBER

2635

DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/807,120

Applicant(s)
Leyden

Examiner
Albert Wong

Group Art Unit
2635



☒ Responsive to communication(s) filed on Dec 19, 2000

☐ This action is **FINAL**.

☒ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 2 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-14 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The Office action is in response to the request for CPA filed December 19, 2000. Claims 1-14 are pending.

Prior rejections withdrawn

2. The prior rejection of the claims have been withdrawn in view of the interview with John Mortimer. A summary of the agreement is stated in the reasons for allowance which is based on the file history and cited references.

Prior rejections maintained

3. NONE.

New rejections

4. NONE.
5. Claims 1-14 are allowed.
6. The following is an examiner's statement of reasons for allowance:

This reason for allowance is based on the interview between the Examiner and John Mortimer. The file history was reviewed, and it was agreed that the claims are not anticipated or made obvious over the prior art of record.

Any determination of obviousness must involve some degree of hindsight, otherwise all claims must be anticipated by prior art. In everyday practice, practitioners modify known inventions to suit particular needs, however, such changes are not necessarily documented. The obviousness standard is based on the legal fiction of one of ordinary skill in the art at the time of the invention. Such a practitioner is endowed with the level of skill and knowledge gleaned from

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all references pertinent to the problem and available at the time and the suggestions therein. At issue is whether impermissible hindsight was used in making the determination that the combination of a retraction means with a multi-conductor cable and a sensor in an alarm environment would have been obviousness. In the instant application the issue is further complicated by the evaluation of secondary considerations. Such considerations include: long felt need and the lack of an acceptable solution.

It is noted that the claimed invention pertains to the field of alarm systems. The issue of cable entanglement in an alarm system is known. The use of a retraction means to windup a non-conductive cable within an alarm system is also known. Finally, retraction means for conductive cables outside of an alarm environment is known. One example cited by the applicant is a typical power cord on an appliance. Another example is cited in U.S. Patent No. 5,535,960 pertaining to a telephone system. Such systems, however, have substantially different requirements than an alarm system. In particular, an alarm system typically has numerous wires instead of one, and the system must be substantially more durable. Initially, it was concluded that the retraction of a non-conductive wire was functionally the same as the retraction of a conductive wire. As shown below, applicant has successfully rebutted this assertion.

First, it is noted that no reference in the alarm art suggests the combination. The Examiner has done a recent updated search and still has found no references (prior art or otherwise) within the alarm field to suggest the combination. The lack of references in the alarm

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art since the original filing of the invention is a suggestion of the nonobviousness of the combination.

Second, Rankin is of particular relevance in the consideration of obviousness. Rankin provides a brief history of the alarm art pertaining to tethered articles in col. 1. Initially, articles were protected by a wire cable attached to a retraction means. This proved to be inadequate because the cable could be cut. Other inventions solved the problem of cut cables by designing a conductive cable that is attached to the article. These device do not include a retraction means. The problem with such devices is the potential for electrical shock if the wire becomes exposed. To remedy the problem, Rankin teaches the use of a non-conductive cable connected to a switch. If the cable is cut, the retraction of the cable actuates a switch which sets off an alarm. Thus, Rankin teaches away from the use of a multi-conductor cable with a retraction means.

Third, regarding the affidavits submitted by the applicant, the Examiner has considered factual statements in the determination of obviousness, instead of mere opinions. The Kuhn affidavit (filed July 22, 1999) states that tethered alarm systems (mechanical and electronic) had problems with cables and that no adequate solution existed. This establishes the need for the system claimed in the application.

The long felt need and the lack of an adequate solution determination is further bolstered by the affidavit from Peter Passuntino (filed December 19, 2000). Of particular note is a discussion of an early solution to the wire problem. Instead of a retraction means, a lead weight

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was attached to the wire to reduce the length of exposed wire. This proved to be an unworkable solution.

In view of the negative teaching, the establishment of a long felt need without an adequate solution as evidenced by Mr. Kuhn's affidavit and the prior solutions recited in Mr. Passuntino's affidavit, it is concluded that the combination of a retraction means in combination with a multi-conductive wire and sensor would not have been obvious to one of ordinary skill in the art at the time of the invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

7. This application is in condition for allowance except for the following formal matters:

Applicant must surrender the original patent prior to the granting of a new patent in a reissue application.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert Wong whose telephone number is 703-305-8884. The examiner can normally be reached on Monday-Thursday from 8:30-6:00.

If attempts to reach the examiner by phone are unsuccessful, the examiners supervisor Mike Horabik can be reached on 703-305-4704.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703-305-4700.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

703-308-9051, (for formal communications intended for entry)

Or:

703-305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


ALBERT K. WONG

ALBERT K. WONG
PATENT EXAMINER

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



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March 8, 2001